

REMARKS

In the Office Action mailed January 14, 2008¹, the Examiner rejected claims 1-6, 8-11, 13-22, 24-35, 37-47, and 50 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2003/0112928 to Brown et al. ("*Brown*") in view of U.S. Patent No. 6,996,227 to Albal et al. ("*Albal*"); and rejected claims 7 and 49 under 35 U.S.C § 103(a) as unpatentable over *Brown* and *Albal*, and further in view of U.S. Patent Publication No. 2003/0069874 to Hertzog et al ("*Hertzog*").

By this Amendment, Applicants have amended claims 1, 13, 18, 27, 37, 46, and 47, and add new claims 51 and 52. Upon entry of this amendment, claims 1-11, 13-22, 24-35, 37-47, and 49-52 will be pending.

I. The Rejection of claims 1-6, 8-11, 13-22, 24-35, 37-47, and 50 under 35 U.S.C. § 103(a)

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicants that such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

predictable to one of ordinary skill in the art” at the time the invention was made.

M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) The factual inquires . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Applicants respectfully traverse the rejection of claims 1-6, 8-11, 13-22, 24-35, 37-47, and 50 under 35 U.S.C. § 103(a).

A. Claims 1-11, 13-17, 27-35, 37-45, and 46

Claim 1 recites a method for logging calls comprising “receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log” (emphasis added).

In contrast, *Brown* discloses a method, system, and program for logging calls according to a call context (*Brown*, abstract). The call context can include the identity of the caller, the device identity, and the owner (*Brown*, ¶ 39); and entities can specify “logging preferences” related to the call context (*Brown*, ¶ 155). However, *Brown* only logs calls if a party to the call requests that a particular call be logged (*Brown*, ¶ 94). Because *Brown* does not log calls unless a party expressly requests call logging, *Brown*’s calling parties would have no need to specifically exclude a call from the log. Therefore, *Brown* fails to render obvious the claimed “receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log” as recited by independent claim 1.

Albal fails to cure the deficiencies of *Brown*. *Albal* discloses storing information in an address book by creating records of telephone calls, and determining if the records match telephone numbers in the address book (*Albal*, abstract). However, while the user can update or change the content in the address book (*Albal*, col. 4, lines 25-27), *Albal* does not disclose or suggest that whether or not the records are stored is based on whether the calls were to a specified phone number. Therefore, *Albal* fails to render obvious the claimed “receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log” as recited by independent claim 1.

Although of different scope, independent claims 27 and 46 are distinguishable over *Brown* and *Albal* for at least the same reasons as claim 1. Because the cited references fail to render obvious the subject matter recited by claims 1, 27, and 46, no prima facie case of obviousness has been established with respect to these claims. Applicants therefore request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Claims 2-6, 8-11, 13-17, and 50 depend from claim 1, and claims 28-35 and 37-45 depend from claim 27, and are allowable not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them from *Brown* and *Albal*.

B. Claims 18-27, 24-26, and 47

Claim 18 recites a method for logging calls comprising “receiving instructions that specify filter settings for logging information associated with the outgoing calls ... the filter settings being specific to each of the plurality of source communication devices associated with the user” (emphasis added).

As discussed, *Brown* discloses a method, system, and program for logging calls according to a call context (*Brown*, abstract), and entities can specify “logging preferences” related to call context (*Brown*, ¶ 155). However, while *Brown* indicates the call context can include device identities (*Brown*, ¶ 39) *Brown* does not disclose or suggest device-specific logging preferences. Therefore, *Brown* fails to render obvious the claimed “receiving instructions that specify filter settings for logging information associated with the outgoing calls ... the filter settings being specific to each of the plurality of source communication devices associated with the user,” (emphasis added) as recited by independent claim 1.

Albal fails to cure the deficiencies of *Brown*. As discussed, *Albal* discloses storing information in an address book by creating records of telephone calls, and determining if the records match telephone numbers in the address book (*Albal*, abstract). However, while the user can update or change the content in the address book (*Albal*, col. 4, lines 25-27), *Albal* does not disclose or suggest that the records are stored based on device-specific filter settings. Therefore, *Albal* fails to render obvious the claimed “receiving ... instructions for excluding at least one outgoing call from a call log, the filter settings being specific to each of a plurality of devices associated with a user” as recited by independent claim 1 (emphasis added).

Although of different scope, independent claim 47 is distinguishable over *Brown* and *Albal* for at least the same reasons as claim 1. Because the cited references fail to render obvious the subject matter recited by claims 18 and 47, no prima facie case of obviousness has been established with respect to these claims. Applicants therefore request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Claims 19-22 and 24-26 depend from claim 18, and are allowable not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them from *Brown* and *Albal*.

II. The Rejection of Claims 7 and 49 under 35 U.S.C § 103(a)

Claims 7 and 49 depend from claim 1, and therefore require all of the elements recited therein. As already discussed, *Brown* and *Albal* fail to render obvious “receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log.”

Hertzog fails to cure the deficiencies of *Brown* and *Albal*. *Hertzog* discloses a database of personal contact information that allows a user to dictate preferences for when their associated contact information is valid (*Hertzog*, abstract). However, *Hertzog* does not disclose or suggest allowing a user to specify a number, where phone calls to the specified number are excluded from a call log. Therefore, *Hertzog* does not render obvious "receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log."

Because the cited references fail to render obvious the subject matter of claims 7 and 49, no prima facie case of obviousness has been established with respect to these claims. Accordingly, Applicants respectfully request the Examiner to withdraw the rejections of these claims under 35 U.S.C. § 103(a).

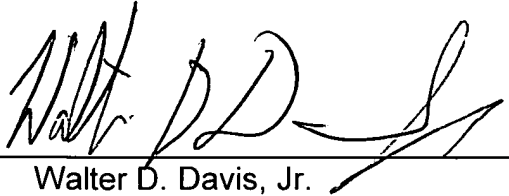
III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Reply, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

Dated: April 14, 2008

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